

REMARKS

This Amendment is responsive to the final Office action mailed September 1, 2005 and is being filed concurrently with a Request for Continued Examination. Claims 54, 55, 57, 60-63 and 66-70 are pending in the application. Claims 54, 55, 57, 60, 61, and 62 have been amended. Claims 56, 58, 59, 64, and 65 have been canceled. No new matter is presented. Reconsideration is respectfully requested.

Personal Interview

Applicant and the undersigned attorney would like to thank the Examiner for the courtesies extended during the personal interview held October 6, 2005. The Interview Summary prepared by the Examiner and initialed by the undersigned attorney accurately reflects the substance of the interview. No further description of the interview is deemed necessary.

Specification

The Examiner has indicated that the title of the invention is not descriptive. The title of the invention has been amended and is indicative of the invention to which the claims are directed.

The specification has been objected to as failing to provide proper antecedent basis for the claim terms "self-sizing," "self-tensioning," "self-adhering," and "self-expanding." Claims relating to "self-attaching," "self-adhering," and "self-expanding," have been canceled. The specification has been amended to further describe the "self-sizing" and "self-tensioning" features of the claimed invention. It is believed that the objection relating to these claim terms has been obviated. No new matter is presented.

Claims Rejections Under 35 U.S.C. § 101

Claims 54-63 and 65-70 have been rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Claims 54, 55, 57, and 62 have been amended in accordance with the Examiner's suggestion by adding the claim language "adapted to." Accordingly, it is believed that the rejection under 35 U.S.C. § 101 has been obviated.

Claim Rejections Under 35 U.S.C. § 112

Claim 65 has been rejected under 35 U.S.C. § 112 in that the claim language "self-expanding" is considered to be new matter and not described in the originally filed specification as required. Claim 65 has been canceled thereby obviating the § 112 rejection.

Claim Objections Under 37 C.F.R. § 1.75

The Examiner has advised that should any of claims 55-58 be found allowable the remainder of the claims will be objected to under 37 C.F.R. § 1.75 as being a substantial duplicate thereof. Applicant respectfully disagrees that the remaining claims are duplicates, however, will reserve further comment pending allowance of now-pending claims 55 and 57.

Claim Rejections Under 35 U.S.C. § 103

Claims 54-63 and 65-70 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Jayaraman (U.S. Patent No. 6,360,749) in view of Lau et al. (U.S. Patent No. 6,517,570). Applicant respectfully traverses. Applicant is submitting concurrently herewith the Declarations of Lilip Lau and Bill Hartigan, the inventors herein, under 37 C.F.R. § 1.131, to antedate the Jayaraman patent. Also attached is the Declaration of Darrel Ogi, an engineer working with the inventors on the cardiac harness project. The '749 patent to Jayaraman issued from U.S. Serial No. 09/414,708 filed

October 8, 1999, and claims priority to Provisional Application No. 60/103,824 filed October 9, 1998. Attached to the Lau Declaration is a copy of the Provisional Application Serial No. 60/103,824. The provisional application does not disclose or teach the elastic bands used by the Examiner in rejecting the claims of the present application. Accordingly, the priority date for the Jayaraman '749 patent is its filing date, October 8, 1999.

As set forth in the Lau, Hartigan and Ogi Declarations, the conception date of the claimed invention is a date prior to October 8, 1999 and all work occurred in the United States, in Palo Alto, California. From a date prior to October 8, 1999, the inventors worked diligently to reduce to practice the claimed invention, and filed Provisional Application No. 60/188,282, filed March 10, 2000, to which the present application claims priority. In view of the foregoing, it is respectfully urged that the Applicant has presented a prima facie case that the claimed invention was conceived prior to the priority date of the Jayaraman '749 patent and that the claimed invention was reduced to practice shortly thereafter, and constructively reduced to practice with the filing of the provisional application. In view of the foregoing, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Double Patenting

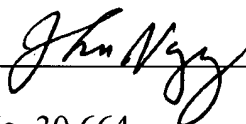
Claims 54-70 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over four U.S. patents and two pending patent applications, all of which are co-owned and co-assigned to Paracor Medical. A terminal disclaimer is being filed concurrently herewith to obviate the double patenting rejection.

Conclusion

Claims 54, 55, 57, 60-63, and 66-70 remain pending in the application. Reconsideration is respectfully requested. If a telephone interview would facilitate prosecution of the application, the undersigned can be reached at (310) 824-5555.

Respectfully submitted,

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